

77

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Case No. 98,189-P1)

In the Application of:

William Richards

Serial No.: 10/601,925

Filed: June 23, 2003

Title: Automated Molecular Pathology Apparatus
Having Independent Slide Heaters



Art Unit: 2171

Examiner: Brian R. Gordon

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

TRANSMITTAL LETTER

In regard to the above identified application:

1. We are transmitting herewith the attached:

- A. Information Disclosure Statement
- B. Form PTO-1449
- C. Copy of Reference Number 74
- D. Return Receipt Postcard

2. With respect to additional fees:

A. No additional fee is required.
 B. Attached is a check in the amount of \$

3. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2490.
A duplicate copy of this sheet is enclosed.

4. CERTIFICATE OF MAILING UNDER 37 CFR § 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 31st of August, 2005.

By C. Blair Hughes
A Blair Hughes
Reg. No. 32,901

McDONNELL BOEHNEN HULBERT
& BERGHOFF
300 South Wacker Drive
Chicago, Illinois 60606



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 98-189-P1)

In the Application of:)
Richards et al.)
Serial No.: 10/601,925) Examiner: Brian R. Gordon
Filing Date: June 23, 2003) Group Art Unit: 1743
For: Automated Molecular Pathology)
Apparatus Having Independent Slide)
Heaters)

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1490

Dear Sir:

Pursuant to 37 C.F.R. Section 1.97 - 1.99, the Applicant wishes to make the following references of record in the above-identified application. This Information Disclosure Statement is in compliance with the continuing duty of candor as set forth in 37 C.F.R. Section 1.56. Pursuant to 37 C.F.R. §1.98(d), copies of references numbered 1-65 and 68-73 are not provided herewith, since they were previously provided in the parent case, U.S. Patent Application Serial No. 09/690,296, filed on October 17, 2000 now U.S. Patent No. 6,582,962 issued June 24, 2003 and U.S. Patent Application Serial No. 09/259,240 filed on February 26, 1999 now U.S. Patent No. 6,296,809 issued October 2, 2001. A copy of reference 74 cited below is enclosed. These references are also listed on the enclosed PTO Form 1449.

In the judgment of the undersigned, portions of the listed references may be material to the Examiner's consideration of the presently pending claims. This statement is not a representation that the listed references have effective dates early enough to be "prior art" within the meaning of 35 U.S.C. Section 102 or Section 103.

U. S. PATENTS

<u>Patent Number</u>	<u>Inventor</u>	<u>Issue Date</u>
1. 3,853,092	Amos et al.	December 10, 1974
2. 3,979,576	Janson	September 7, 1976
3. 3,997,634	Downs	December 14, 1976
4. 4,043,292	Rogers et al	August 23, 1977
5. 4,092,952	Wilkie et al.	June 6, 1978
6. 4,358,470	Rasmussen	November 9, 1982
7. 4,384,193	Kledzik et al	May 17, 1983
8. 4,430,299	Horne	February 7, 1984
9. 4,543,236	von Gise	September 24, 1985
10. 4,629,126	Goudy et al.	December 16, 1986
11. 4,629,862	Kitagawa et al.	December 16, 1986
12. 4,647,431	Sekine et al.	March 3, 1987
13. 4,695,430	Coville et al.	September 22, 1987
14. 4,731,335	Brigati	March 15, 1988
15. 4,847,208	Bogen	November 7, 1989
16. 4,858,155	Okawa et al.	August 15, 1989
17. 4,865,986	Coy et al.	September 12, 1989
18. 4,933,146	Meyer et al.	June 12, 1990
19. 4,695,430	Coville et al.	September 22, 1987
20. 4,731,335	Brigati	March 15, 1988
21. 4,847,208	Bogen	July 11, 1989
22. 4,858,155	Okawa et al.	August 15, 1989
23. 4,865,986	Coy et al.	September 12, 1989
24. 4,933,146	Meyer et al.	June 12, 1990
25. 4,985,206	Bowman	January 15, 1991
26. 5,073,504	Bogen	December 17, 1991
27. 5,075,079	Kerr et al.	December 24, 1991

<u>Patent Number</u>	<u>Inventor</u>	<u>Issue Date</u>
28. 5,089,229	Heidt et al.	February 18, 1992
29. 5,093,557	Lok et al.	March 3, 1992
30. 5,105,066	Houdy et al.	April 14, 1992
31. 5,154,889	Muraishi	October 13, 1992
32. 5,207,987	Kureshy et al.	May 4, 1993
33. 5,231,029	Wootton et al.	July 27, 1993
34. 5,246,665	Tyranski et al.	September 21, 1993
35. 5,273,905	Muller et al.	December 28, 1993
36. 5,280,156	Niori et al	January 18, 1994
37. 5,314,825	Weyrauch et al.	May 24, 1994
38. 5,316,452	Bogen et al.	May 31, 1994
39. 5,425,918	Healey et al.	June 20, 1995
40. 5,439,649	Tsueng et al.	July 8, 1995
41. 5,475,610	Atwood et al.	December 12, 1995
42. 5,496,518	Arai et al.	March 5, 1996
43. 5,523,056	Miller	June 4, 1996
44. 5,595,707	Copeland et al.	January 21, 1997
45. 5,601,141	Gordon et al.	February 11, 1997
46. 5,645,114	Bogen et al.	July 8, 1997
47. 5,819,842	Potter et al.	October 13, 1998
48. 5,849,489	Heller	December 15, 1998
49. 5,922,604	Stapleton et al.	July 13, 1999
50. 5,947,167	Bogen et al.	September 7, 1999
51. 5,985,672	Kegelman et al.	November 6, 1999
52. 6,020,141	Pantoliano et al.	February 1, 2000
53. 6,027,890	Ness et al.	February 22, 2000
54. 6,036,920	Pantoliano et al.	March 14, 2000
55. 6,096,271	Bogen	August 1, 2000
56. 6,162,926	Murphy et al.	December 19, 2000
57. 6,180,060	Green et al.	January 30, 2001

<u>Patent Number</u>	<u>Inventor</u>	<u>Issue Date</u>
58. 6,183,693	Bogen et al.	February 6, 2001
59. 6,238,866	Yeh et al.	May 29, 2001
60. 6,268,158	Pantoliano et al.	July 31, 2001
61. 6,268,218	Pantoliano et al.	July 31, 2001
62. 6,274,323	Bruchez et al.	August 14, 2001
63. 6,291,191	Pantoliano et al.	September 18, 2001
64. 6,291,192	Pantoliano et al.	September 18, 2001
65. 6,300,068	Burg et al.	October 9, 2001
66. 5,538,871	Nuovo et al.	July 23, 1996
67. 5,654,199	Copeland et al.	August 5, 1997

FOREIGN PATENTS

<u>Patent Number</u>	<u>Country</u>	<u>Publication Date</u>
68. EPO 017 766	Europe	March 14, 1980
69. EPO 201 780	Europe	November 20, 1986
70. WO 93/09486	PCT	May 13, 1993

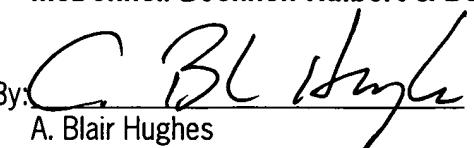
OTHER DOCUMENTS

71. Stoss, W.P., et al., "Automation of APAAP Immunocytochemical Technique," *J. Clin. Pathol.*, 42:106-112 (1989).
72. Stark, E., et al., "An Automated Device for Immunocytochemistry," *Journal of Immunological Methods*, 107:89-92 (1988).
73. MaWhinney, W.H.B., et al., "Automated Immunochemistry," *J. Clin. Pathol.*, 43(7):591-596 (1990).
74. Nuovo, "In Situ PCR: Protocols and Applications," *PCR Methods and Applications*, pp. 151-167 (1995)

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff LLP

Date: August 31, 2005

By:


A. Blair Hughes
Reg. No. 32,901

FORM PTO-1449
(Rev. 2-32)U.S. Department of Commerce
Patent and Trademark OfficeAtty. Docket No.
98,189-P1Serial No.
10/601,925INFORMATION DISCLOSURE
STATEMENT BY APPLICANT

(Use several sheets if necessary)

Applicant:
Richards, et al.Filing Date:
6/23/03Group:
1743

U.S. PATENT DOCUMENTS

Examiner Initial		Document Number	Date	Name	Class	Subclass	Filing Date if Appropriate
		3,853,092	12/10/74	Amos et al.			
		3,979,576	09/07/76	Janson			
		3,997,634	12/14/76	Downs			
		4,043,292	08/23/77	Rogers et al.			
		4,092,952	06/06/78	Wilkie et al.			
		4,358,470	11/09/82	Rasmussen			
		4,384,193	05/17/83	Kledzik, et al.			
		4,430,299	02/07/84	Horne			
		4,543,236	09/24/85	von Gise			
		4,629,126	12/16/86	Goudy et al.			
		4,629,862	12/16/86	Kitagawa, et al.			
		4,647,431	03/03/87	Sekine et al.			
		4,695,430	09/22/87	Coville et al.			
		4,731,335	03/15/88	Brigati			
		4,847,208	07/11/89	Bogen			
		4,858,155	08/15/89	Okawa et al.			
		4,865,986	09/12/89	Coy et al.			
		4,933,146	06/12/90	Meyer et al.			
EXAMINER				DATE CONSIDERED			

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication.

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		4,695,430	9/22/87	Coville et al.			
		4,731,335	3/15/98	Brigati			
		4,847,208	7/11/89	Bogen			
		4,858,155	8/15/89	Okawa et al.			
		4,865,986	9/12/89	Coy et al.			
		4,933,146	6/12/90	Meyer et al.			
		4,985,206	01/15/91	Bowman et al.			
		5,073,504	12/17/91	Bogen			
		5,075,079	12/24/91	Kerr et al.			
		5,089,229	02/18/92	Heidt et al.			
		5,093,557	03/03/92	Lok et al.			
		5,105,066	04/14/92	Houdy et al.			
		5,154,889	10/13/92	Muraishi			
		5,207,987	05/04/93	Kureshy et al.			
		5,231,029	07/27/93	Wootton et al.			
		5,246,665	09/21/93	Tyranski et al.			
		5,273,905	12/28/93	Muller et al.			
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(Use several sheets if necessary)		Applicant: Richards, et al.	
		Filing Date: 6/23/03	Group: 1743

U.S. PATENT DOCUMENTS

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		5,208,156	1/18/94	Niori et al.			
		5,314,825	5/24/94	Weyrauch et al.			
		5,316,452	5/31/94	Bogen et al.			
		5,425,918	6/20/95	Healey et al.			
		5,439,649	7/8/95	Tsueng et al.			
		5,475,610	12/12/95	Atwood et al.			
		5,496,518	03/05/96	Arai et al.			
		5,523,056	06/04/96	Miller			
		5,595,707	01/21/97	Copeland et al.			
		5,601,141	02/11/97	Gordon et al.			
		5,645,114	07/08/97	Bogen et al.			
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		5,849,489	12/15/98	Heller			
		5,922,604	7/13/99	Stapleton et al.			
		5,947,167	09/07/99	Bogen et al.			
		5,985,672	11/16/99	Kegelman et al.			
		6,020,141	2/1/00	Pantoliano et al.			
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		6,027,890	2/22/00	Ness et al.			
		6,036,920	3/14/00	Pantoliano et al.			
		6,096,271	8/1/00	Bogen			
		6,162,926	12/19/00	Murphy et al.			
		6,180,060	1/30/01	Green et al.			
		6,183,693	2/6/01	Bogen et al.			
		6,238,866	5/29/01	Yeh et al.			
		6,268,158	7/31/01	Pantoliano et al			
		6,268,218	7/31/01	Pantoliano et al.			
		6,274,323	8/14/01	Bruchez et al.			
		6,291,191	9/18/01	Pantoliano et al.			
		6,291,192	9/18/01	Pantoliano et al.			
		6,300,068	10/9/01	Burg et al			
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	Document Number	Date	Country	Class	Subclass	Translation	
						Yes	No
	EP0 017 766	03/14/80	Europe				
	EP0 201 780	11/20/86	Europe				
	WO 93/09486	05/13/93	PCT				

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc).

		Stoss, W.P., et al., "Automation of APAAP Immunocytochemical Technique," <i>J. Clin. Pathol.</i> , 42:106-112 (1989).
		Stark, E., et al., "An Automated Device for Immunocytochemistry," <i>Journal of Immunological Methods</i> , 107:89-92 (1988).
		MaWhinney, W.H.B., et al., "Automated Immunochemistry," <i>J. Clin. Pathol.</i> , 43(7):591-596 (1990).
		Nuovo, "In Situ PCR: Protocols and Application", <i>PCR Methods and Applications</i> , pp. 151-167 (1995)
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